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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,586	01/26/2004	Jurgen Zeltner	A-3877	1729

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EXAMINER

MORRISON, THOMAS A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,586

Applicant(s)

ZELTNER ET AL.

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/26/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 01/26/2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. In particular, Swiss Patent No. 369475 has not been considered, because this reference is not in the English language and no explanation of its relevance was included.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, (1) the machine drive of the processing machine set forth in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: (1) the specification fails to provide proper antecedent basis for the recited sheet processing machine in claim 1; (2) the specification fails to provide proper antecedent basis for the recited drive assemblies in claim 1; (3) the specification fails to provide proper antecedent basis for the recited drive train in claim 1; (4) the specification fails to provide proper antecedent basis for the recited clutch selectively switchable **with a determined angular position into said drive train between said drive assembly of the sheet feeder and the machine drive of the sheet processing machine** in claim 1; (5) the specification fails to provide proper antecedent basis for the recited machine drive in claim 2; (6) the specification fails to provide proper antecedent basis for the recited sheet processing machine in claim 2; (7) the specification fails to provide proper antecedent basis for the recited drive

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assemblies in claim 3; (8) the specification fails to provide proper antecedent basis for the recited machine drive in claim 7; (9) the specification fails to provide proper antecedent basis for the recited drive assemblies in claim 7; (10) the specification fails to provide proper antecedent basis for the recited machine drive in claim 9; (11) the specification fails to provide proper antecedent basis for the recited drive assemblies in claim 9; (12) the specification fails to provide proper antecedent basis for the recited machine drive in claim 10; (13) the specification fails to provide proper antecedent basis for the recited drive train in claim 10; and (14) the specification fails to provide proper antecedent basis for the recited pulley wheel in claim 10.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the recited clutch selectively switchable with a determined angular position into said drive train between said drive assembly of the sheet feeder and the machine drive of the sheet processing machine in claim 1 was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 10, it is unclear if applicant is trying to claim the sheet feeder by itself or the combination of the sheet feeder and the sheet processing machine. For example, claim 1 recites elements of the sheet feeder, as well as an element of the sheet processing machine. As another example, claim 10 further defines an element of the sheet processing machine.

Regarding claim 1, it is unclear what is meant by the recitation, "a clutch selectively switchable with a **determined angular position into said drive train** between said drive assembly of the sheet feeder and the machine drive of the sheet processing machine". (emphasis added).

Claim 1 recites the limitation "said drive assembly" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 6, it is unclear where the recited carriage is located. What is the carriage connected to?

Claims 6-7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: (1) the structural

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relationship in claim 6, between the second spring element and the carriage, that causes the carriage to be in a pretensioned state in an operating position; (2) the structural relationship in claim 7, between the first spring element and the drive assemblies that allows the first spring element to absorb a torque surge introduced when the machine drive is first connected to the drive assemblies of the sheet feeder; (3) the structural relationship in claim 7, between the second spring element and the switch-on torque limiter that allows the second spring element to cushion a recoil movement of the switch-on torque limiter; (4) the structural relationship in claim 9, between the actuating motor, the carriage, the machine drive and the drive assemblies, that allows the phase to be adjusted between the machine drive and the drive assemblies; and (5) the structural relationship in claim 10, between the actuating motor, the carriage, the pinion and the pulley wheel, that allows a phase between the pinion and the pulley wheel to be adjusted.

Claim 8 recites, "said first spring element and said second spring element are disposed coaxially inside one another". Which spring element is inside? One possible solution would be to amend claim 8 to recite that the first spring element and the second spring element are disposed coaxially with the first spring element disposed inside the second spring element.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,118,091 (Nagamoto et al.).

Regarding claim 1, Figs. 1-6 show a sheet feeder for the synchronized feeding of sheets to a sheet processing machine (see e.g., 30a and 30b and column 8, line 58 to column 9, line 8) having a machine drive (including 35), the sheet feeder comprising: drive assemblies (including 3, 3, 4a and 4b) for driving the sheet feeder and a drive train (Fig. 1) connecting the drive assemblies (including 3, 3, 4a and 4b) to the machine drive (including 35) of the sheet processing machine (see 30a and 30b and column 8, line 58 to column 9, line 8);

a clutch (11) selectively switchable with a determined angular position into the drive train (Fig. 1) between the drive assembly (including 3, 3, 4a and 4b) of the sheet feeder and the machine drive (including 35) of the sheet processing machine (see 30a and 30b and column 8, line 58 to column 9, line 8); and

a switch-on torque limiter (including 42) with a pretensioned spring element (40) connected in the drive train (Fig. 1).

Regarding claim 2, Figs. 1-6 show that the switch-on torque limiter (including 42) is disposed between the machine drive (including 35) of the sheet processing machine and the clutch (11).

Regarding claim 3, Figs. 1-6 show that the switch-on torque limiter (including 42) is disposed between the clutch (11) and the drive assemblies of the sheet feeder.

Conclusion

7. The fact that not all of the claims have been rejected in view of prior art is not an indication that such claims contain allowable subject matter, particularly in view of the rejections under 35 U.S.C. 112 outlined above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

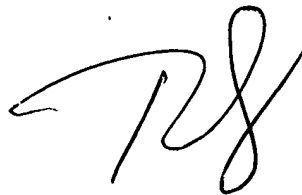
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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

08/22/2006

A handwritten signature in black ink, appearing to be 'PM' or similar initials, written in a cursive style.

**PATRICK MACKEY
PRIMARY EXAMINER**